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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1953

NO. 424

WESTINGHOUSE ELECTRIC CORPORATION,
a corporation,
Petitioner,

v.

BULLDOG ELECTRIC PRODUCTS COMPANY,
a corporation,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

I. SUMMARY STATEMENT OF THE MATTERS INVOLVED

This is an action brought in the United States District Court for the Northern District of West Virginia by Westinghouse Electric Corporation, petitioner herein, against Bulldog Electric Products Company, respondent herein, for infringement of patents relating to electric circuit breakers. The trial was by the court without a jury and a judgment was rendered in favor of the respondent. An appeal from said judgment in respect to certain of said patents was taken by the petitioner herein to the

United States Court of Appeals for the Fourth Circuit, which affirmed the judgment of the District Court. The principal questions involved on said appeal were the validity and infringement of said patents.

The opinion of the District Court is reported in 106 F. Supp. 819 and the opinion of the Court of Appeals in 98 USPQ 300 (not yet published in Federal Reporter). Prior opinions on a motion for summary judgment are reported in 81 F. Supp. 987 and in 179 F. 2d 139.

The patents involved cover small circuit breakers for protecting the electric wiring in buildings, such as homes, stores and offices. These circuit breakers protect the wiring against overloads and short circuits and eliminate the inconveniences and dangers of the ordinary electric fuse. Such circuit breakers have a handle which may be operated as a switch to turn the current on and off, and there is a bimetallic thermostat which releases the mechanism upon the occurrence of an excessive current to cause opening of the circuit. After the cause of the overload has been remedied, the contacts may be reclosed by movement of the handle.

Three of the above-mentioned patents are relied upon here. They are Hodgkins No. 2,073,103 (Exhibit 20, R. 9), Swingle No. 2,329,362 (Exhibit 21, R. 25) and Jennings No. 2,190,517 (Exhibit 22, R. 49). The accused circuit breakers of respondent are called by the trade names "Pushmatic" and "Circuit Master". These devices are shown on the colored charts, Exhibits 27 and 33 (following R. 383).

II. JURISDICTIONAL STATEMENT

The judgment of the Circuit Court of Appeals was entered on July 24, 1953 (R. 694). The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254 (1).

III. QUESTIONS PRESENTED

The questions herein presented are the validity and infringement of said three patents, namely, Hodgkins 2,073,103 (claims 31, 32, 33 and 39-44); Jennings 2,190,517 (claims 15, 19-23, 25 and 27-35); and Swingle 2,329,362 (claims 27, 53, 54, 69, 70 and 70-80). A defense of alleged unclean hands or misuse of patents was asserted but was held to be unfounded in said opinions on the merits by the District Court and the Court of Appeals (R-679).

IV. REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

1. The decisions herein holding the Hodgkins and Jennings patents invalid are in conflict with decisions in the case of Westinghouse Electric & Mfg. Co. v. Frank Adam Electric Co. in the Eighth Circuit where, as stated in an opinion by the Court of Appeals on a collateral issue (146 F. 2d 165), the District Court held the same two patents to be valid and where the Court of Appeals accepted, by logical inference, the findings of validity.

This Court has regularly granted certiorari to resolve conflicts between courts of appeals for different circuits with respect to the validity or infringement of patents. See, for example, *General Electric* v. *Jewell*, 326 U. S. 242, 243; *Mandel* v. *Wallace*, 335 U. S. 291, 292; *Jengersen* v. *Ostby & Barton*, 335 U. S. 560, 561 and *Bassick* v. *Hollingshead*, 298 U. S. 415, 416.

The parties herein stipulated (R. 278-9 and 289-90) and the Fourth Circuit Court of Appeals recognized (R. 684 and 687) that the Hodgkins and Jennings patents had been held to be valid in the unreported decision of the District Court for the Eastern District of Missouri. The appeal to

the Court of Appeals for the Eighth Circuit included the issue of validity of the patents. That Court might have disposed of the entire suit by reversing the District Court's holding of validity, but it did not do so. Instead, the case was remanded for the taking of additional evidence on an unclean hands defense. While the Eighth Circuit Court of Appeals stated in its opinion that it did not decide the merits of the appeal, the only logical inference which can be drawn from its action in remanding the case is that it was convinced as to the soundness of the District Court's holding of validity, since the exclusion by the lower court of the evidence on the unclean hands defense would have made no difference if the patents were invalid. If either defense were good, the final result would be dismissal of the complaint.

It must be presumed that the Court of Appeals would not put the parties to the expense of taking additional testimony on an issue which would be moot if the patents were invalid. This is supported by the fact that in the case of *Koochook Co.* v. *Barrett,* 158 F. 2d 463, which was decided in the following year by the same Court of Appeals, with its decision in the *Westinghouse* v. *Frank Adam* case cited on the point at page 467, the Court did not remand for the taking of excluded evidence, but held the patent invalid. Therefore, the Court's decision remanding the *Frank Adam* case for the taking of excluded evidence on the unclean hands defense was, in effect, a confirmation of the District Court's holding that the patents were valid. The decision of the Court of Appeals of the Fourth Circuit in the instant case is thus in conflict not only with the decision of the District Court in Missouri, but also with this ruling by the Court of Appeals for the Eighth Circuit.

Furthermore, the practical effect of the decision of the

Eighth Circuit Court of Appeals was much the same as if it had affirmed the decision of the District Court. This result obtained because the defendant in the *Frank Adam* case, on remand, apparently realized that there was no basis for the unclean hands defense (as has been held in the instant case by both the District Court at R. 381 and by the Court of Appeals at R. 679) and took a license requiring it to pay a royalty of 3% on all circuit breakers covered by the Hodgkins or Jennings patents. A copy of this license is in evidence here as Exhibit 592 B. Thus the Frank Adam Company in the Eighth Circuit must pay royalty for use of the patents, while the Bulldog Company will be free, as a result of the decision in the Fourth Circuit, unless certiorari is granted to resolve the conflict of opinion in the two Circuits with respect to the validity of the patents.

It should be noted that the conflict of decision as to validity is one of the application of law, since substantially the same prior art patents were before the courts of the two Circuits. The main patents relied upon in the Fourth Circuit in holding invalidity were Krantz 1,726,233; German patent to Felten No. 198,249; Laganke 1,789,183; Weber 743,207, and De Reamer 1,494,221 (R. 682-689); and these same patents were found in the Eighth Circuit not to anticipate (R. 278-9 and 289-90). The additional patents referred to in the opinions in the Fourth Circuit are not of controlling significance, but are largely cumulative and show devices similar to those shown in the patents that were relied upon by the defendants in both cases. This is not a case where there was discovered for use in the second suit some previously overlooked anticipation. The different results in the two Circuits were thus occasioned by a conflict as to the interpretation of the law. This con-

flict between circuits should therefore be resolved by the grant of a writ of certiorari in the instant case.

2. The decision of the Court below is in conflict with the applicable decisions of this Court regarding (a) construction of patent claims, (b) what constitutes patentable invention and (c) priority of invention between rival inventors.

(a) The decision of the Court of Appeals in discussing the Hodgkins patent stated (R. 685) that it "must be precisely limited" to the "particular arrangement" illustrated and described in the patent, and substantially similar holdings were made with respect to Jennings (R. 688-9) and Swingle (R. 692). The decision in this regard is in conflict with the principles of patent law laid down in decisions of this Court. As demonstrated in Plaintiff's Exhibit 44 (R. 65), the claims in suit of the Hodgkins patent apply, element for element and function for function, to the respective devices of the respondent, shown in the charts following R. 383. Similarly the claims in suit of Swingle and Jennings patents are shown by Exhibit 45 (R. 73) and Exhibit 46 (R. 82) to apply in like manner to the accused devices against which they are asserted.

The Court of Appeals decision, however, ignores the wording of the claims and holds that there is no infringement because of mere differences of form which are not specified in the claims. This makes a nullity of the claims which are required by statute and is directly contrary to the decisions of this Court in *Smith* v. *Snow*, 294 U. S. 1, 11; *Continental Paper Bag Co.* v. *Eastern*, 210 U. S. 405, 418-9; *Exhibit Supply Co.* v. *Ace*, 315 U. S. 126, 130; *Milcor Steel Co* v. *Fuller*, 316 U. S. 143, 145-6 and *Graver Mfg. Co.* v. *Linde*, 339 U. S. 605, 607.

In the latter case this Court said:

> "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.
>
> "But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system."

In the instant case it is not even necessary for petitioner to rely on the doctrine of equivalents, since the accused devices fall clearly within the claims.

The holding (R. 689) that the Swingle patent must be limited to a device having two operating springs (when the claims clearly and admittedly call for only one), based on the argument that the second spring is necessary to an operative structure and that the claims must be construed to include all the elements of the complete operative device,

is contrary to the decision of this Court in *Deering* v. *Winona,* 155 U. S. 286, 302, in which it is stated:

> "Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described in the patent as rendering it operative must be read into the claim."

(b) The decision of the Court of Appeals that the claims of Hodgkins, Jennings and Swingle do not define patentable devices (R. 685, 688-9 and 692) and are invalid for want of patentable invention, is contrary to the principles enunciated by this Court in *Expanded Metal Co.* v. *Bradford,* 214 U. S. 366, 381; *Temco* v. *Apco,* 275 U. S. 319, 328; *Goodyear Co.* v. *Ray-O-Vac,* 321 U. S. 275, 279; and *Eibel Co.* v. *Paper Co.,* 261 U. S. 45, 63 where the Court said:

> "In the case before us, for the reasons we have already reviewed, we think that Eibel made a very useful discovery which has substantially advanced the art. His was not a pioneer patent, creating a new art; but a patent which is only an improvement on an old machine may be very meritorious and entitled to liberal treatment. Indeed, when one notes the crude working of machines of famous pioneer inventions and discoveries, and compares them with the modern machines and processes exemplifying the principle of the pioneer discovery, one hesitates in the division of credit between the original inventor and the improvers; and certainly finds no reason to withhold from the really meritorious improver, the application of the rule *"ut res magis valeat quam pereat,'* which has been sustained in so many cases in this Court."

(c) The holding that the Jennings patent is anticipated by the work of Christensen (R. 687) notwithstanding the established fact that Jennings date of invention was in

October, 1935, at least two months before Christensen claimed to have conceived in December, 1935, certain parts of the invention, is contrary to *Marconi* v. *United States*, 320 U. S. 1, 34, in which this court held that the one who was first to conceive and did not abandon his invention is the prior inventor.

3. The scope and validity of the Hodgkins, Jennings and Swingle patents are of great importance because of the large volume of business involved, the number of licensees under these patents, and the deterrent effect of the existing uncertainty upon the further development of the circuit breaker industry.

The Hodgkins and Swingle patents cover circuit breakers known in the industry as "Multi-breakers" (R. 168) and the Jennings patent covers circuit breakers known by the name "Quicklag" (R. 169). Sales of Multi-breakers and Multi-breaker equipment by Westinghouse up to the date of the trial (January, 1951) exceeded $3,000,000 (Tr. 341-2 and 1851-6) and sales by Westinghouse of the Quicklag breaker up to the same date exceeded $5,500,000 (Tr. 587).

In addition, Westinghouse has granted licenses under the Hodgkins and Swingle patents to other manufacturers of Multi-breakers (Ex. 592 and 592 A) as follows:

Cutler-Hammer, Inc.
Square D Company
Trumbull Electrical Manufacturing Co.
Federal Electric Products Co.
Arrow-Hart & Hegeman Electric Co.

These licensees have sold many millions of dollars worth of Multi-breaker equipment. For example, the Square D Company alone sold over $30,000,000 worth of Multi-breaker

equipment on which it paid Westinghouse royalties of over $750,000 (Tr. 1872).

Licenses had been granted, up to the date of the trial, under the Jennings and other patents for the manufacture of Quicklag breakers (Tr. 1892) as follows:

I-T-E Circuit Breaker Co.
Cutler-Hammer, Inc.
Frank Adam Electric Co.
Federal Electric Products Co.

The Quicklag and Multi-breakers are used largely by the building industry in the construction and remodeling of the electric installations in homes, stores, offices, schools and hospitals. The patents on these circuit breakers have now been in continuous litigation in the lower courts for fourteen years, the *Frank Adam* suit having been filed October 17, 1939. Such a long period of litigation, with conflicting opinions, leaves the industry in a state of confusion.

Not only are the petitioner and its licensees affected by the decisions of the courts below, but practically an entire large industry is concerned, since there is now uncertainty as to whether other manufacturers require licenses for their operations and as to whether actions for infringement can be maintained against those whose products respond to the terms of the Westinghouse patents. Such manufacturers should become licensees or should be prosecuted for infringement if said patents are valid, as they have been held to be in the Eighth Circuit and not in the Fourth Circuit.

Further development of the circuit breaker industry is retarded by the uncertainty. Petitioner, as owner of the three patents here involved, does not know whether any

additional investment which it may make in developing the business will be protected by its patents. Other manufacturers desiring to enter this circuit breaker field do not know whether their investment will be jeopardized by the uncertain results of additional patent litigation, or whether a license should be obtained under the patents.

It is therefore a matter of great public importance that the validity of these patents, on two of which there have been conflicting decisions, be authoritatively determined by this Court.

Wherefore, your petitioner prays that, in view of the conflict of decision between the courts of the Fourth and Eighth Circuits, the failure of the Fourth Circuit Court of Appeals to follow the applicable decisions of this Court and the exceptional public importance of the matters involved, a writ of certiorari issue under the seal of this Court, directed to the Court of Appeals for the Fourth Circuit, to the end that this cause may be reviewed and determined by this Court as provided for by the statutes of the United States; that the judgment of said Court of Appeals for the Fourth Circuit be reversed; and that your petitioner be granted such further relief as to this Court may seem proper.

Dated October 20, 1953.

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

I. OPINIONS BELOW

The District Court opinion is reported at 106 Fed. Supp. 819, and that of the Court of Appeals at 206 F. (2d) 574.

II. JURISDICTION

Jurisdictional requisites are adequately stated in the petition.

III. QUESTIONS PRESENTED

The petition states the formal questions presented, namely, the questions of validity and infringement of the three United States Letters Patent. In Hodgkins Patent No. 2,073,103, the claims in issue specified in the petition are only 9 of 44 claims contained in the patent; in Jennings Patent No. 2,190,517, the claims in issue specified in the petition are only 15 of 35 claims contained in the patent; and in Swingle Patent No. 2,329,362, the claims in issue specified in the petition are only 16 of the 84 claims contained in the patent. The remaining claims of each patent were not in issue.

If the petition were granted, respondent, in addition to defenses against alleged infringement and validity, would urge also the defense of unclean hands arising out of misuse of the patents by petitioner.

IV. STATEMENT

The concurring decisions of the Courts below are based essentially upon determination of questions of fact. Substantial evidence in support appears in the record, particularly the BullDog Appendix, Volume 1, in which pages 29-136 contain testimony respecting the Hodgkins Patent No. 2,073,103; pages 137-259 respecting the Jennings Patent No. 2,190,517; and pages 260-358 respecting the Swingle Patent No. 2,329,362. The petition makes no charge that

the determinations of fact by the Courts below are not supported by substantial evidence in the record.

It was found (District Court findings, Westinghouse Appendix, pp. 246-249) that:

In general, circuit breakers of the kind which are the subject of the patents in suit and the parts that go to make them up—such as terminals, contacts, fixed and movable, movable contact— or switch—arms, handles and springs, and various additional mechanical elements for moving the contact or switch arm to open and closed position, and bimetallic and electro-magnetic devices for providing automatic opening of the movable contact or switch arms—were old and known prior to the patents in suit. (BullDog Appendix, Volume II, prior art patents, particularly British Patent to Holmes No. 17,888, page 423; United States Patents to Von Hoorn No. 1,786,796, page 369; Krantz No. 1,726,233, page 361; Laganke No. 1,789,183, page 447; Laganke No. 2,025,872, page 487; Getchell No. 1,761,117, page 480; No. 1,759,395, page 473; and No. 1,886,477, page 438; Jennings No. 1,794,901, page 530; and Taylor No. 2,018,904, page 493.)

No commercial use has been made of the circuit breaker constructions shown in the drawings and described in the specifications of the Hodgkins patent No. 2,073,103, the Jennings patent No. 2,190,517, and the Swingle patent No. 2,329,362, in suit. Petitioner's commercial breakers, Multi-breaker and Quicklag, bear little or no resemblance to the circuit breaker constructions shown in the drawings and described in the specifications of these patents. (BullDog Appendix, Volume I, pp. 101-2, 235-40, 249-50, 275-6, 284-5, 345-6.)

Petitioner's Multi-breaker and Quicklag breakers, sales of which petitioner relies upon for alleged commercial

success of the patents in suit, are covered by other patents not asserted in this suit to be infringed by respondent (BullDog Appendix, Volume I, pp. 101-4, 236).

Petitioner has granted licenses under its patents for the manufacture of Multi-breakers and Quicklag breakers, and that such of those licenses as are in evidence here contain a large number of circuit breaker patents other than the patents asserted in this suit to be infringed (Ex. 59?, pp. 1-10, 11-16, 12-17, 31-47).

Respondent's circuit breakers, the Circuit Master and the Pushmatic, are substantially different in construction and arrangement of parts from the circuit breakers shown in the drawings and described in the specifications of the patents charged to be infringed (BullDog Appendix, Volume I, pp. 88-91, 158-160, 330-1, 342 and prior testimony beginning at 285).

The Circuit Master and Pushmatic also are substantially different in construction and arrangement of parts from petitioner's commercial breakers, the Multi-breaker and the Quicklag.

Respondent's Circuit Master and Pushmatic do not copy or imitate either the breaker constructions shown in the drawings and described in the specifications of the patents in suit, or petitioner's commercial breakers, the Multi-breaker or the Quicklag.

The detailed findings of the District Court with respect to the Hodgkins Patent No. 2,073,103 appear in the Westinghouse Appendix, pp. 278-289; those with respect to the Jennings Patent No. 2,190,517 appear at pages 289-315; and those with respect to the Swingle Patent No. 2,329,362 at pages 329-341.

After reviewing the prior art, considering the claims of the patents in suit alleged to be infringed in their relation

to the structures disclosed in the patents in suit, the prior art and respondent's circuit breakers alleged to infringe, the District Court concluded (District Court conclusions 2 and 3, Westinghouse Appendix pp. 357-358) that none of the patents in suit are pioneer patents entitled to a wide range of equivalents; that all are improvement patents, and are to be construed in the light of their respective specifications and drawings, and of the prior art, and limited substantially to the devices disclosed in their respective specifications and drawings, and also that respondent's circuit breakers, Circuit Master and Pushmatic, are not in any material or substantial respect similar to the devices disclosed in the drawings and specifications of the patents in suit; and that the drawings and specifications of those patents fail to suggest the construction of respondent's circuit breakers; and that none of the patents in suit are entitled to any range of equivalents that will include respondent's Circuit Master and Pushmatic within their scope; that the claims of those patents asserted to be infringed, when construed in the light of the specifications and drawings of the respective patents in which they are contained and given the meanings there intended, fail to find any response in respondent's circuit breakers.

The District Court's additional conclusions with specific reference to the Hodgkins Patent No. 2,073,103, the Jennings Patent No. 2,190,517, and the Swingle Patent No. 2,329,362, are Nos. 6, 7, 8 and 9 (Westinghouse Appendix, pp. 360-363) and Nos. 13, 14 and 15 (Westinghouse Appendix, pp. 365-367) in which the facts previously found with respect to the validity and alleged infringement of these patents are summarized.

With respect to the Hodgkins Patent No. 2,073,103, the Court of Appeals (Proceedings, Court of Appeals, 4th Circ., pp. 685-6) in affirming the District Court stated:

"Here again we have, at best, a combination patent in a crowded field. All of the important elements in Hodgkins, performing substantially the same functions, may clearly be found in the prior art cited by the District Judge, especially Laganke, No. 1,789,183. And particularly germane are the three cases cited by him in this connection. Indeed, all that Hodgkins accomplished was a rather clever *arrangement* of these elements which possessed some novelty. Manifestly, this patent must be precisely limited to that particular arrangement. As thus limited, all the claims in suit and their specifications fall far short of patentable invention. The Hodgkins patent must, therefore, be declared invalid.

* * *

"We agree with the District Judge that if, under a strict construction of its claims and specifications, the Hodgkins patent should be held valid, it is not infringed by Pushmatic and Circuit Master, the accused devices of BullDog. Counsel for Westinghouse strongly stress in parallel columns of their brief the similarities between Hodgkins, on the one hand, and Pushmatic and Circuit Master on the other. Some of these similarities are inconsequential. Of many more it may truthfully be said that these same similarities may be observed when Hodgkins is compared with the prior art.

"* * * We are also impressed, as was the District Judge, by the testimony of Professor Hoover, BullDog's expert witness, to the effect that there is nothing in the drawings and specifications of the Hodgkins patent that would teach how to design or construct the Circuit Master or the Pushmatic."

With respect to the Jennings Patent No. 2,190,517, the Court of Appeals (Proceedings, Court of Appeals, 4th Circuit, pp. 688-9) in affirming the District Court stated:

"What has been previously said as to the Hodgkins patent seems even truer as to the Jennings patent. Here, again, we find in the prior art all the elements in Jennings, with these elements performing the same functions. This patent, too, is subsequent to Hodgkins and Jackson, No. 2,096,546. All that Jennings has done here is to devise a new arrangement of the old elements, which is, at best a mere nonpatentable aggregation.

"When, as must be the case, the claims and specifications of Jennings are strictly construed, they are not infringed by either Circuit Master or Pushmatic. * * *"

With respect to the Swingle Patent No. 2,329,362, the Court of Appeals (Proceedings, Court of Appeals, 4th Circuit, p. 692) in affirming stated:

"We think the Swingle patent falls in the same category with, and is subject to the same objections as, Hodgkins and Jennings. Once more we find in the prior art all the important elements of Swingle, all performing the same essential functions. The chronology and factual circumstances surrounding its grant seem to strengthen the view that Swingle discloses no more than a mere nonpatentable aggregation.

"Swingle did not originate, and there is nothing new in automatic overload circuit breakers in which all operations are controlled by a single or identical pair of overcenter springs, a so-called 'floating' switch arm operating about two pivot points, a circuit breaker having two main movable members, a handle, and a switch arm having a movable contact rigidly mounted upon it and operated by a single overcenter spring in both manual and overload operations."

The claims in issue of the patents in suit are worded in vague and general terms. The other claims of those patents

directed to the specific improvement disclosed in the drawings and specifications were never charged to be infringed and are not in issue.

There is no conflict in the decisions of Courts of Appeal respecting validity or infringement of the Swingle Patent No. 2,329,362. This patent was not at issue in the case of *Westinghouse v. Frank Adam Electric Co., post,* in the 8th Circuit.

With respect to the alleged conflict between Courts of Appeal regarding the validity of the Hodgkins Patent No. 2,073,103 and the Jennings Patent No. 2,190,517, it appears clearly in the opinion of the Court of Appeals for the 8th Circuit in *Westinghouse Electric & Mfg. Co. v. Frank Adam Electric Co.,* 146 F. (2d) 165, that the judgment of the District Court holding the Hodgkins patent valid and infringed and Jennings valid but not infringed was not reviewed or considered by the Court of Appeals. That Court vacated the judgment and remanded the case to the District Court with instructions to take evidence on the issue of unclean hands arising out of alleged misuse of the patents. The record in the case at bar does not disclose that the judgment of the District Court in the *Westinghouse v. Adam* case was ever reinstated. It is conceded by petitioner that the case was settled between the parties after remand. The record of the case at bar does not disclose the circuit breaker construction found to infringe the Hodgkins patent nor what claims of either the Hodgkins patent or the Jennings patent were found valid or infringed by the District Court in Missouri, nor the considerations upon which such findings were made.

V. ARGUMENT

There is no Conflict of Decision Between Courts of Appeal for Different Circuits With Respect to the Validity or Infringement of the Hodgkins Patent or the Jennings Patent

The Court of Appeals for the 8th Circuit did not consider or pass upon or render decision with respect to the validity or infringement of either of those patents. It is clear from its opinion, 146 F (2d) 165, that there can be no inference whatever that it upheld the validity or infringement of those patents, in the face of the fact that it vacated the judgment of the District Court holding such patents valid.

As a matter of interest, the Court of Appeals for the 8th Circuit three months later in a different case, *Frank Adam Electric Co. v. Colt's Patent Fire Arms Mfg. Co.*, 148 F. (2d) 497, in reversing the District Court and holding invalid for want of invention other patents in the circuit breaker art contemporaneous with those in the case at bar, found (p. 500) the circuit breaker art crowded almost to the point of suffocation.

It is apparent that petitioner's ground for certiorari based upon conflict of decisions of different Courts of Appeal is without foundation, and that its argument that the Court of Appeals for the 8th Circuit accepted by logical inference the District Court judgment of validity which it vacated, is without foundation or support in the record.

The Decision of the Court Below is not in Conflict With the Applicable Decisions of This Court Regarding (a) Construction of Patent Claims, (b) What Constitutes Patentable Invention, and (c) Priority of Invention Between Rival Inventors

The petitioner avers that the Court of Appeals ignored the wording of the claims and held that there is no infringement because of mere differences of form which are not specified in the claims, and that this makes a nullity of these claims and is contrary to the cited decisions of this Court.

The Courts below have not ignored the wording of the claims in issue of the patents in suit. Those claims are couched in broad, general and vague terms, susceptible of broad or narrow interpretation depending upon the facts found with respect to the nature and extent of invention disclosed in the drawings and specifications of the patents when assessed in comparison with and in the light of the prior art.

The Courts below found the nature and extent of the alleged inventions of the patents over and in view of the prior art to be very narrow and limited, and in considering the question of infringement construed the vague and general terms of the claims accordingly. It gave those terms the meaning required when applied to the specific constructions disclosed in the drawings and specifications of the patents in which they are contained, and so construed found them not to cover or be infringed by the substantially different constructions and arrangements of respondent's circuit breakers.

In this the Courts below did not come in conflict with applicable decisions of this Court. In a leading decision of this Court in *Eibel Process Co. v. Minnesota & Ontario*

Paper Co., 261 U. S. 45, 63, this Court defined the principles to be observed in administering the Patent Law and stated:

> "In administering the Patent Law the court first looks into the art, to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially; and if it has done so, the court is liberal in its construction of the patent to secure to the inventor the reward he deserves.
>
> "If what a patentee has done works only a slight step forward, and that which he says is a discovery is on the borderline between mere mechanical change and real invention, the patent, if sustained, will be given narrow scope, and infringement will be found only in approximate copies of the new device."

In the case at bar the Courts below found as a matter of fact that the patents contained little if any invention over the prior art and accordingly gave them a narrow scope and refused to find infringement by respondent's breakers which were substantially different from and found not to be approximate copies of the breakers disclosed in the patents.

This is not in conflict with decisions of this Court referred to in the petition as the nature and extent of the inventions of the patents here in suit are found to be of little, if any merit, while the nature and extent of the inventions of the patents involved in the cases cited by petitioner were found to be of substantial merit.

Petitioner quotes the decision of this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U. S. 605-607, in that part of the opinion which states that if the accused matter falls clearly within the words of the claim,

infringement is made out and that is the end of it, and that imitation of a patented invention which does not copy every literal detail does not avoid infringement.

The part of that opinion quoted by petitioner is not applicable in the case at bar for the reason that in the cited case the Courts below in concurring decisions had found substantial and meritorious invention over the prior art in the patent involved.

In the case at bar the Courts below have concurred in finding that there is no such invention in the claims in issue of the patents in suit.

Furthermore, petitioner in its reliance upon the *Graver v. Linde* case, ignores the fact that the decision, at page 609, recognizes the established rule stated and applied in *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, to the effect that infringement is not made out even though the accused device corresponds with the letter of the claims of the patent asserted to be infringed where the accused device is so far changed in principle from the patented article that it performs the same or similar function in a substantially different way, but nevertheless falls within the literal words of the claim.

The Courts below in the case at bar have concurred in finding that respondent's accused circuit breakers are so different from the circuit breakers shown in the drawings and disclosed in the specifications of the patents in suit that they do not infringe even though they might be brought within the vague and general terminology of the claims asserted, as petitioner endeavored to do.

Petitioner's argument that it is error to limit the claims in issues of the Swingle patent to a device having two operating springs on the ground that the second spring is essential to the operative structure disclosed in the

drawings and specification of the patent, in view of the decision of this Court in *Deering v. Winona Harvester Works,* 155 U. S. 286, 302, takes no account of the fact that in *Deering v. Winona* (p. 302) the device described by the claim there involved was a pivotal extension to a butt-adjuster newly invented by the patentee and required only conventional means to carrry out its operation, while in the case at bar the Courts below have concurred in finding not only that Swingle did not disclose invention of a device that would operate with a single spring, but also that circuit breakers of the same character operated by a single overcenter spring were old in the art, that Swingle was not entitled in view of the art to predicate invention upon that feature, and that respondent's circuit breaker followed the constructions of the prior art and not that of Swingle.

Petitioner's argument that the decision of the Court of Appeals that the claims in issue of Hodgkins, Jennings and Swingle are invalid for want of patentable invention is contrary to the principles announced by this Court in the decisions cited in the petition, is in error in that it fails to recognize that in the cases cited the Court found the inventions involved to have substantially advanced the art, whereas in the case at bar the Courts below have concurred in finding that the patents in suit have not substantially advanced the art and are but slightly different arrangements of old devices and that respondent has not copied or imitated these arrangements in its circuit breakers.

As stated before (pp. 10-11) in the very decision of *Eibel Process Co. v. Minnesota & Ontario Paper Co.,* 261 U. S. 45, upon which petitioner relies, the Court stated that where the discovery of the patent is on the borderline between mere mechanical change and real invention the

patent, if sustained, will be given a narrow scope and infringement found only in approximate copies of the device.

In the case at bar the Courts below have concurred in finding as fact little or no invention in the claims in issue of the patents in suit in view of the prior art.

Petitioner's contention that the holding that the Jennings patent in suit is anticipated by the work of Christensen is contrary to decision of this Court in *Marconi Wireless Telegraph Co. v. United States,* 320 U. S. 1, 34, holding that one who was the first to conceive and did not abandon his invention is the prior inventor, ignores the fact that the Courts below concurred in the holding that Jennings is not shown by any corroborated evidence to have conceived the invention involved in October, 1935, as petitioner states, or prior to June 5, 1936, which was after conception and reduction to practice of the invention by Christensen. (District Court findings, Westinghouse Appendix, pp. 297-299; District Court conclusions Nos. 8 and 9, Westinghouse Appendix, pp. 362-363; Evidence, BullDog Appendix, Volume III; Westinghouse Appendix, pp. 101-123).

The Scope and Validity of the Hodgkins, Jennings and Swingle Patents are Not of Great Importance

Petitioner's argument that the scope and validity of the Hodgkins, Jennings and Swingle patents are of great importance because of the large volume of business involved, the number of licensees under the patents, and the deterrent effect of existing uncertainty upon further development of the circuit breaker industry, is unfounded and without support in the record.

It is conceded that no circuit breakers of the construction shown in the drawings and described in the specifi-

cations of these patents have ever been produced commercially by either petitioner or its licensees. It is conceded that petitioner's commercial breakers, the Multi-breaker and Quicklag, alleged to be made under these patents, are covered by other patents not involved in this suit, and that the licenses under which these commercial breakers are made by others include a large number of other patents which are not here involved. (Statement, p. 3-4.)

There is no evidence in the record establishing that the large volume of business in Multi-breaker and Quicklag circuit breakers is due to the patents in suit, rather than to other patents covering those breakers which are not in suit.

In these circumstances commercial success of the Multi-breaker and the Quicklag cannot be attributed to the patents in suit or the circuit breaker constructions disclosed therein, nor can those patents rightly be said to be of great commercial importance.

> *Murray-Ohio Manufacturing Co. v. E. C. Brown Co.*, 124 F. (2d) 426, 428, (C. C. A. 6);
> *Leahman Co. of America v. Kroll Brothers Co.*, 139 F. (2d) 391, 393 (C. C. A. 7);
> *DeCew v. Union Bag and Paper Corp.*, 57 Fed. Supp. 388, 399-400 (D. C. N. J.).

There is nothing in the decisions of the Courts below which prevents or precludes the manufacture of circuit breakers by the industry, or which prevents or precludes petitioner from making new developments or inventions in circuit breakers, or which prevents or precludes petitioner from selling or any in the industry from taking licenses under petitioner's patents if they so desire.

VI. CONCLUSIONS

For the foregoing reasons it is respectfully submitted that the petition for writ of certiorari should be denied.

Respectfully submitted,

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Counsel for Respondent.

Dated: November ..., 1953.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1953

No. 424

WESTINGHOUSE ELECTRIC CORPORATION,
a corporation,
Petitioner,

v.

BULLDOG ELECTRIC PRODUCTS COMPANY,
a corporation,
Respondent.

REPLY BRIEF FOR PETITIONER ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT

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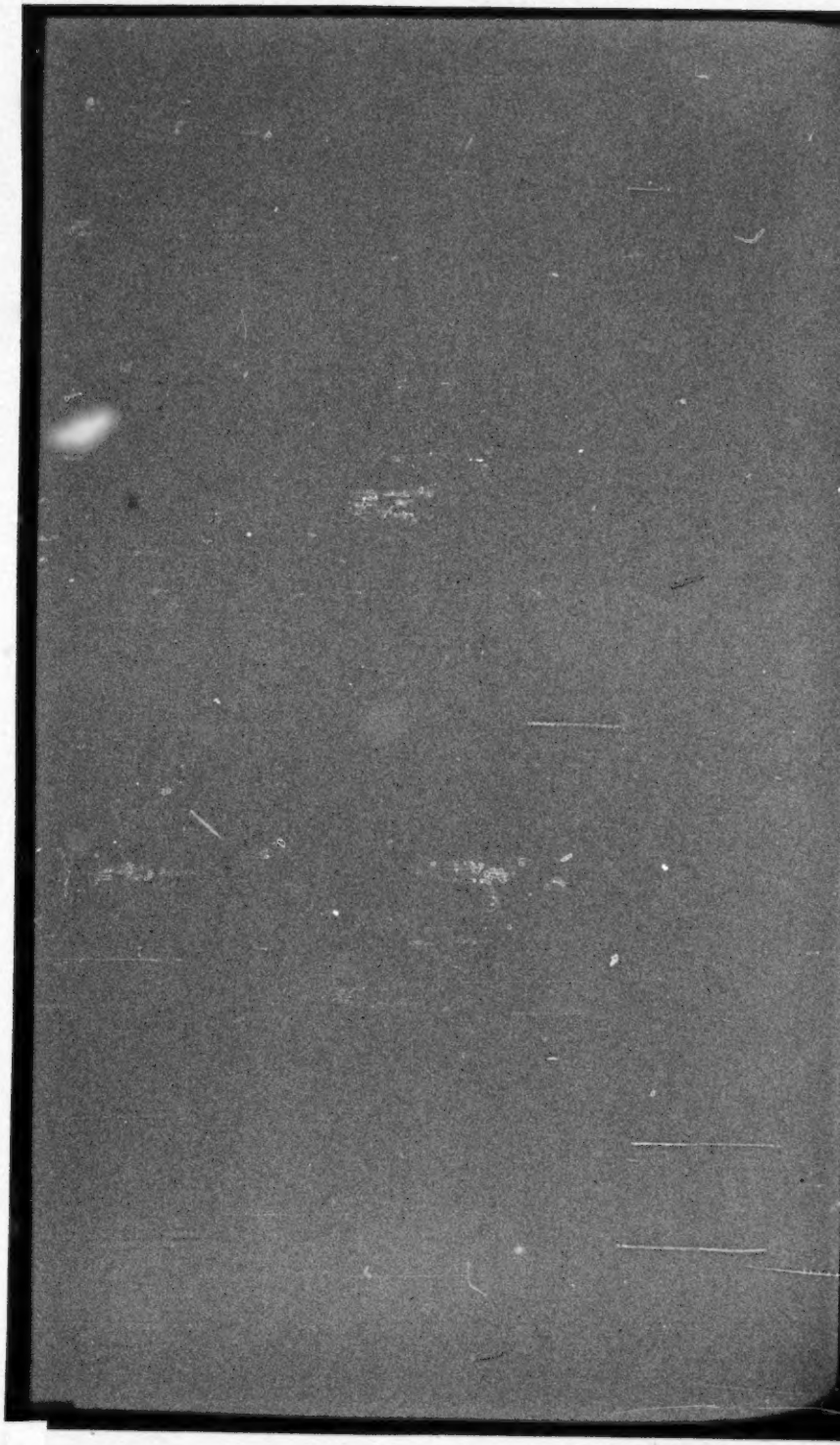

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Only a very short reply to the Respondent's brief is deemed necessary.

Respondent states on page 2 of its brief that the decisions below "are based essentially upon determination of questions of fact." This ignores the direct statement in the concurring opinion of Mr. Justice Douglas (apparently speaking for the Court in this regard) in *A. & P. Tea Co. v. Supermarket Co.*, 340 U. S. 147, 155-6, that "the question of validity of a patent is a question of law."

In regard to commercial use of the inventions of the three patents here involved, Respondent states, on page 3 of its brief, that no commercial use has been made "c

the circuit breaker constructions shown in the drawings and described in the specifications" of these patents. A similar assertion is also made at pages 14 and 15 but Respondent does not refute our statement, which is fully supported by the record (R. 168 and 169 and elsewhere), that the claims of the Hodgkins and Swingle patents cover the "Multi-breaker" and those of the Jennings patent cover the "Quicklag" breaker, both of which devices have admittedly had extensive commercial use. As stated, for example, in the often-quoted case of *Smith* v. *Snow,* 294 U. S. 1, 11, a patentee is not confined to the illustrative embodiment of an invention shown in his drawings and described in his specifications "since the claims of the patent, not its specifications, measure the invention."

Respondent asserts on page 8 of its brief that the record in the case at bar does not disclose that the judgment in the case of *Westinghouse Electric & Mfg. Co.* v. *Frank Adam Electric Co.,* (C. A. Opinion, 146 F. 2d 165) "was ever reinstated" or "what claims of either the Hodgkins patent or the Jennings patent were found valid or infringed by the District Court in Missouri." It is submitted that it is immaterial whether or not the judgment was ever formally reinstated, since it was never reversed and the defendant took a license because of it. As to the claims, the Eighth Circuit Court of Appeals said (p. 166) that "After trial upon the merits the court [below] found and decreed that all of the patents in suit are valid as to all the claims sued upon; that Hodgkins 2,073,103 has been infringed as to all claims sued upon * * *". The claims there in suit were specifically set out in the decree, which is a matter of court record, and, as to the two patents referred to, include claims that were held invalid by the Court of Appeals for the Fourth Circuit in the instant case.

The case in the Eighth Circuit Court of Appeals was fully briefed and argued on the merits, as appears from the opinion (p. 166), and, as pointed out in the petition, there would have been no occasion or necessity to remand the case for a trial on the unclean hands issue if the Court had been of the opinion that the patents involved were invalid over the prior art. As stated in the petition, the logical inference from the action taken by the Court of Appeals is that it, in effect, confirmed the findings of the District Court on validity, as otherwise it would presumably have disposed of the case on that issue, as it did in the case of *Koochook* v. *Barrett*, 158 F. 2d 463 (cited in the petition), instead of putting the parties to the trouble and expense of supplemental proceedings on the unclean hands question that would have been wholly unnecessary if the patents had been found to be invalid. The present case thus presents a genuine conflict between the two Circuits as asserted in the petition.

The case referred to on page 9 of Respondent's brief, namely, *Frank Adam Electric Co.* v. *Colt's Patent Fire Arms Mfg. Co.*, 148 F. 2d 497, involved some detail patents of the Colt's Co. and the statement (to the effect that the circuit breaker art was crowded) referred to in the brief was made in a report of a special master holding one of such patents valid and infringed, which report was sustained by the District Court in a decree that was reversed by the Court of Appeals. Clearly the master's comment is neither pertinent nor competent here.

Respondent's brief makes repeated references (as at pages 2, 12 and 14) to the fact that the courts below "concurred" in their findings but that is immaterial here since there is a conflict in findings and conclusions between the courts in the Eighth and Fourth Circuits which should be

resolved by this Court. *Sanitary Refrigerator Co.* v. *Winters et al.*, 280 U. S. 30, 36; *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 180; and *Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445, 447.

It of course will be understood that the fact that various statements made in the Respondent's brief, having to do with the merits of the issues of validity and infringement that will be in issue if the petition is granted, are not answered in this reply brief does not mean that Petitioner acquiesces therein or agrees as to their accuracy.

It is submitted that adequate grounds for allowance of the writ have been shown in the petition and have not been successfully refuted in the Respondent's brief.

Respectfully submitted,

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November 27, 1953